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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/633,253 | 08/04/2003 | Tomoyuki Ohzeki | FSF-031431 | 6336 |

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EXAMINER

CHEA, THORL

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1752

DATE MAILED: 05/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/633,253

Applicant(s)

OHZEKI ET AL.

Examiner

Thorl Chea

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-45 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) 39-45 is/are allowed.
6) ☒ Claim(s) 21-38 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 21-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The scope of protection sought for the "precursor" of the compound of formula (4) is unclear since the specification fails to describe as to what the precursor of that formula.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 21-30 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Okada et al (US Patent No. 6,120,983).

See the composition of the photothermographic material of Okada in the abstract which contains known silver salt, photosensitive silver halide, reducing agent and binder; the exemplified

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compounds in columns 11-20 compounds 1-55 which contains a compound having property within the scope of "a compound having a group that is adsorptive to silver halide and a group that reduces a silver halide, or a precursor of the compound having a group that is adsorptive to silver halide and a group that reduces a silver halide". Silver halide including silver iodide and silver bromiodide having iodide content of 0.1 to 40 mole % in column 36, lines 4-15; the size of silver halide from 20 nm to 120 nm in column 35, lines 38-50; binder including poly(vinylbutyral) in column 41, lines 13-52; and the compound within the scope of formula (4) of the claimed invention exemplified in column 13-14 having a reducing group including hydroxyurea such as 7-11. Okada et al discloses the silver halide including silver iodide, silver bromiodide having iodide content up to 40 mole % and the compound within the scope of the formula (4) claimed in the present claimed invention. The scope of the claims anticipates Okada et al when silver iodide or silver bromiodide having iodide content of 40 mole % and the compound having hydroxyurea. The silver bromiodide having iodide content of 40 mole % is within the scope of most preferred by Okada et al. The worker of ordinary skill in the art would have envisaged the silver bromiodide having iodide content would be the most effective when used in combination with the exemplified compound including that containing hydroxyurea group. Therefore, the invention as claimed is anticipated by Okada; alternatively, it would have been obvious to the worker of ordinary skill in the art at the time the invention was made to use the silver halide suggested including silver iodide and others to provide an invention as claimed.

6. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Okada et al as applied to claims 21-30 above, and further in view of Siga et al (US Patent No. 4,332,889). Siga discloses the use of silver bromiodide having molar ratio of silver iodide and bromide preferably

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from 30/70 to 98/2 in column 6, lines 60-65 to provide a photothermographic material to have improved spectral sensitivity as well as storage stability. It would have been obvious to incorporate silver bromide having molar ratio of silver iodide and bromide preferably from 30/70 to 98/2 taught in Siga et al in the material taught in Okada et al for same reason, and thereby provide a material as claimed.

7. Claims 31-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Okada et al (US Patent No. 6,120,983) or Kato et al (US Patent No. 5,968,725) in view of Mifune et al (US Patent No. 4,334,010).

Okada et al and Kato et al each discloses a photothermographic material substantially as claimed, except the compound of formula (1) claimed in the present claimed invention. See the teaching of Okada et al in the paragraph 3 above and Kato et al in the abstract. Mifune discloses the compound of formula (1) of the claimed invention to prevent silver halide latent image from fading. See compound in the abstract, columns 4-6 and column 7, lines 41-55. It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to use the compound taught in Mifune et al in the material of Okada et al or Kato et al for same reason taught in Mifune, and thereby provide an invention as claimed.

8. Claims 39-45 are allowed.

Response to Arguments

9. Applicant's arguments filed March 2, 2005 have been fully considered but they are not persuasive for the reason set forth in the rejection above. It is the Examiner's position that the Okada et al anticipate the claimed invention since the silver halide having iodide content of 40 mole % is within the range preferred by Okda et al. The compound of formula of formula (4) is

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the preferred compound. The Declaration under 37 CFR 1.132 on March 2, 2005 fails to overcome the rejection since "(E)vidence of secondary considerations, such as unexpected results or commercial success, is irrelevant to 35 U.S.C 102 rejections and thus cannot overcome a rejection so based. In re Wiggins, 488 F.2d 538, 543, 179 USPQ 421, 425 (CCPA 1973). Moreover, the Declaration fails to overcome the rejection under 35 USC 103(a) since it is not commensurate with the scope of the claimed invention. First, the claims encompasses the scope of silver iodide from 40 to 100 mole %, whereas the results in the Declaration shows only a single value of silver iodide of 40 mole %. The reference discloses both silver bromodide having iodide content of 40 mole % and silver iodide. Second, the results is not consistent with the specification disclosure. The specification disclosure fails as originally filed fails to recognize the advantage of the reducing group such as hydroxyurea or phenidine over the other known reducing agent such as phenol group present in the Declaration. Third, the results such as storage stability or post-development stability would have expected from the group such as mercapto group associated with the compound taught in Okada et al. Fourth, the Declaration fails to compare the results shown in Okada et al such as relative sensitivity or gradient in Tables 1, 2 of Okada et al. Therefore, it is improper to compare the results disclosed in Okada et al and that of the claimed material. Fifth, the Declaration is irrelevant to the rejection set forth in the paragraph 7 above.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (571)272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tchea *th*
April 23, 2005

Thorl Chea
Thorl Chea
Primary Examiner
Art Unit 1752